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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,911	06/26/2003	Eugene H. Carlson	55313US010	5716

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EXAMINER

PURVIS, SUE A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/606,911		CARLSON ET AL.	
	Examiner		Art Unit	
	Sue A. Purvis		1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-14 and 16-26 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>29 Jun 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12-14, 16, 18, 19, 21-23, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen (US Patent No. 5,916,399) in view of Orensteen et al. (US Patent No. 5,706,133).

Olsen discloses a retro reflective transfer sheet material where carrier (16) includes a plurality of discrete segments (20, 24) with an adhesive surface (28) and the viewing surface (26) being attached to the carrier (16). The adhesive surface (28) is applied to the substrate (30). (Figures 1 and 2; Col. 8, lines 6-24.)

Olsen does not disclose protecting the adhesive (28) with a release surface.

Orensteen discloses making retro reflective articles where the articles are fed in a roll of sheeting (20) and transferred to the substrate at a station (300). In particular it is important to note that the resulting retro reflective article is stored in roll form. (See Figure 3.)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to feed the material in Olsen in roll form as shown in Orensteen, because a roll of articles adhered to a sheet is a well known method of storing and then feeding flexible articles to be transfer. As such, the adhesive of the articles in Olsen would be protected by the carrier until the article is unrolled.

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Regarding claims 13 and 22, Olsen in view of Orensteen includes a supply roll.

Regarding claim 14, when the article is unrolled, a release liner is removed.

Regarding claims 16 and 23, where the carrier is removed, a major viewing surface is exposed.

Regarding claim 18, a retro reflective article by its very definition is eye catching and has the quality or state of being attracting attention or being the quality or state of being conspicuity. They are known in the art to be used to on trucks and other vehicles at night.

Regarding claim 19, Olsen teachings using hot melt adhesive. (See Claim 14.)

Regarding claim 25, the adhesion force with respect to the carrier would need to be less than the adhesion force to the substrate, because the article is removed the article to be placed onto the substrate. This is a well known feature of labels which are carried on carriers, then placed on articles.

Regarding claim 26, Orensteen shows that enclosed lens sheeting is known for retro reflective articles.

3. Claims 17, 20, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen in view of Orensteen as described above with respect to claims 12, 18, and 21 above, and further in view of Bacon, Jr. et al. (US Patent No. 6,508,559).

Olsen in view of Orensteen does not disclose the extensibility of the carrier web.

Bacon, Jr. discloses that it is known in the art to have an extensible carrier web, especially when the material is meant to be "conformable."

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an extensible carrier web in the method of Olsen in view of Orensteen, because of the teaching in Bacon where an extensible carrier web helps in the transfer process.

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Allowable Subject Matter

4. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is an examiner's statement of reasons for allowance: There is no reason or suggestion in the prior art for partially tearing the carrier along a plurality of discontinuities during the step of applying the adhesive surface of the sheeting to the flexible substrate.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

6. Applicant's arguments filed 08 June 2004 have been fully considered but they are not persuasive.

7. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

8. Applicant's contention that Olsen does not mention a roll is not argued, that is shown in Orensteen. Flexible articles, such as labels, are typically stored in roll form allowing for easy transport and use. This is well known in the art. Olsen teaches a flat sheet process, but one of ordinary skill in the art would know that a roll process is an obvious alternative, especially based on the teachings of Orensteen which shows retro reflective articles being stored in roll form.

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9. As for applicant's contention that Orensteen is concerned with the transfer of material, examiner does not disagree, but of note to the examiner in Orensteen was not the transfer of the material, but that the material was stored in roll form once it was transferred.

10. Regarding claim 18, as described above retro reflective articles are often defined as properties which allow people to see them at night. This particular word which that applicant is using is used in Janovec et al. (US Patent No. 6,004,422) in combination with retro reflective, showing that it is known in the art that these retro reflective articles are to increase safety and conspicuity during times of low visibility.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Sue A. Purvis", with a long horizontal stroke extending to the right.

Sue A. Purvis
Primary Examiner
Art Unit 1734

SP
August 18, 2004